

REMARKS

Claims 1-16 are pending in the present application. Claims 1, 7 and 13 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 1-16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

The Examiner first states it is unclear what type of attribute is being examined and if the long description is within the first or second document. Applicants have amended Claims 1, 7 and 13 to clarify the attribute, and to make clear that (i) the second electronic document contains the long description, and (ii) the image is within the first electronic document.

The Examiner next states that the term adjacent is unclear. Applicants have amended Claims 1, 7 and 13 to eliminate this terminology. Specification support for this change is shown to be at Specification page 15, lines 20-31.

The Examiner goes on to state that a subtree "presenting" a renderable hyperlink is unclear, and Applicants have amended this terminology in Claims 1, 7 and 13 to eliminate the term "presents".

Finally, the Examiner states that the step of rendering a hyperlink is unclear as to what hyperlink is rendered. Applicants have amended Claims 1, 7 and 13 to clearly define what hyperlink is rendered.

Therefore the rejection of Claims 1-16 under 35 U.S.C. § 112, second paragraph has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-16 under 35 U.S.C. § 103 as being unpatentable over Mackenty et al., USPN 6,085,161 in view of HTML 4.01 Specification, W3C Recommendation 24 December 1999. This rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Applicants will now show that the Examiner has failed to establish a *prima facie* showing of obviousness, as the Examiner has failed to establish, or even assert, that all of the claim limitations are taught or suggested by the cited art. Accordingly, the rejection is improper. In addition, as all other statutory requirements have been met, Applicants are entitled to a patent, per *In re Oetiker*, *Id.*

Claim 1 expressly recites the claimed feature of "creating a new subtree within the document object model of the first electronic document, wherein the subtree is a first sibling node following the image in the document object model, and wherein the subtree comprises a renderable hyperlink to the second electronic document containing the long description of the image". This claimed feature advantageously allows for improved document processing, by reducing internal tracking requirements for images and their associated attributes (such as an attribute that names a uniform resource locator address for a second electronic document) (Specification page 14, lines 6-23).

In rejecting Claim 1, the Examiner alleges that the cited Mackenty reference teaches a "parsing" step at col. 1, lines 60-67 and col. 4, lines 50-65; and a "determining step at col. 5, lines 7-30. The Examiner then states that the Mackenty reference does not explicitly state a "long description", but that such "long description" feature is taught by the cited HTML reference. Notably absent is any assertion on the Examiner's part as to any teaching or suggestion of the claimed "creating a new subtree within the document object model of the first electronic document" step that is expressly cited in Claim 1.

This is likely because none of the cited references teach or suggest such (missing) claimed "creating" step. Because none of the cited references teach or suggest the claimed "creating a new subtree within the document object model of the first electronic document" step – nor has the Examiner even alleged any such teaching or suggestion – it is shown that the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1.

Therefore, Applicants have shown above that the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1, as the Examiner has failed to establish, or even assert, that all of the claim limitations are taught or suggested by the cited art. Accordingly, the rejection of Claim 1 under 35 U.S.C. § 103 is improper. In addition, as all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 1, per *In re Oetiker*, Id.

Applicants initially traverse the rejection of Claims 2-6 for reasons given above with respect to Claim 1 (of which Claims 2-6 depend upon).

Further with respect to Claim 6, such claim recites steps of "duplicating the attribute, if there are multiple images within the document object model which correspond to the attribute", and "placing the duplicate attributes adjacent to all corresponding images within the document object model". These claimed steps advantageously provide an ability to make duplicate copies of the attribute so that the copies are adjacent to their corresponding images (Specification page 14, lines 18-23). In rejecting Claim 6, the Examiner states that MacKentry teaches that each marker contains a unique identifier, which is associated with the position of the .enqueue cursor at the time the marker is enqueued; and that as the synthesizer reads the text enqueued in it, it notifies the Reader as it encounters the markers enqueued along with the text (citing MacKentry col. 6, lines 1-19). Applicants respectfully submit that these "markers" are placed in a speech synthesizer queue (MacKentry Col. 5, lines 66-67). While they may be associated with positions in the HTML tree (the DOM), they are not a part of such HTML tree, but rather are part of a queue that is input to the speech synthesizer (see also MacKentry Col. 6, lines 10-11 and 20-27). Thus, this cited passage does not teach placing the duplicate attributes adjacent to all corresponding images *within the document*

object model", as expressly recited in Claim 6. Thus, it is further shown that Claim 6 is not obvious in view of the cited references.

Applicants traverse the rejection of Claims 7 (and dependent Claims 8-12) and 13 (and dependent Claims 14-16) for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 16, Applicants further traverse such rejection for similar reasons to the further reasons given above with respect to Claim 6.

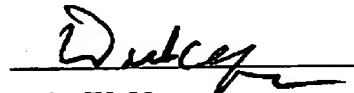
Therefore, the rejection of Claims 1-16 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 10/26/04

Respectfully submitted,



Duke W. Yee
Reg. No. 34,285
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicant